THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN FRANCOIS DEPATIE, J. KELLY LEE, ALLAN MACGREGOR WAUGH and JAMES J. PARKER, JR.

Appeal No. 96-1425
Application No. 08/133,492[1]

ON BRIEF

Before HAIRSTON, MARTIN and CARMICHAEL, Administrative Patent Judges.

CARMICHAEL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-17, which constitute all the claims remaining in the application.

Claim 1 reads as follows:

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[1] Application for patent filed October 7, 1993.

1. A device for controlling a stepper motor that drives one or more camera elements, in which the rotation and position of the rotor of the stepper motor is monitored to determine when the next step of the stepper motor should be stepped, said device characterized by:

a rotor positional indicator having equally spaced first and second areas that are a whole number multiple of the number of steps for one full revolution of the rotor of the stepper motor;

means coupled to said indicator for detecting the transitions between said first and second areas; and

means coupled to said detecting means for rotating the rotor of the stepper motor relative to the position of the rotor of the stepper motor so that the stepper motor has the proper number of steps to cause the camera element to move to the correct position.

The Examiner's Answer cites the following prior art:

Erlichman	4,196,987	Apr. 8, 1980
Sakai et al. (Sakai)	4,812,727	Mar. 14, 1989
Ishimaru	5,057,859	Oct. 15, 1991

OPINION

Claims 1-13 stand rejected under 35 U.S.C. § 103 as unpatentable over Ishimaru and Sakai. Claims 14-17 stand rejected under 35 U.S.C. § 103 as unpatentable over Ishimaru and Sakai as applied to claims 1-13, further in view of Erlichman.

We reverse for the reasons given by appellants, amplified as follows.

The examiner concedes, and we agree, that none of the references teaches or suggests a rotor positional indicator having equally spaced first and second areas "that are a whole number multiple of the number of steps for one full revolution of the rotor of the stepper motor" as recited in the claims. To fill in that gap, the examiner states that the specific number of areas "is considered a matter of convenience." Examiner's Answer at 4.

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); ***In re Chu***, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995).

In the present case, the examiner has not shown that the prior art suggested the desirability of the modification. Stating that the recited element is merely "a matter of convenience" does not satisfy the examiner's burden under ***In***

re Fritch. Upon our own review of the references, we are unable to identify any prior art teaching suggesting the desirability of making the number of indicator areas equal to a whole number multiple of the number of steps for one full revolution of a stepper motor rotor. Therefore, the rejections will not be sustained.

Moreover, the examiner has improperly relied on the appellant's own disclosure to support the "convenience" rationale. Examiner's Answer at 9, lines 5-7.

CONCLUSION

The rejections of claims 1-17 are not sustained.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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) BOARD OF PATENT
JOHN C. MARTIN) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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Appeal No. 96-1425
Application No. 08/133,492

APJ CARMICHAEL

APJ HAIRSTON

APJ MARTIN

REVERSED

July 19, 1999